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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/234,253    01/20/99    SELTZER

R    A-21835/P2/C

000324    IM22/0801  
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PATENT DEPARTMENT  
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EXAMINER

ALVO, M

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 08/01/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/234,253

Applicant(s)  
SELTZER et al

Examiner  
Steve Alvo

Group Art Unit  
1731



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above, claim(s) 12-34 and 41-43 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 and 35-40 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This application contains claims directed to the following patentably distinct species of the claimed invention: the hydroxylamines of claim 4; the acid salts of claim 3 and the stabilizers of claim 7.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, e.g. a single reaction catalyst, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 -11 and 35-40 are generic.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-40, drawn to composition for reducing loss in brightness, classified in Class 162, subclass 72.

III. Claim <sup>41-43</sup>~~18~~<sub>2</sub>, drawn to a method for enhancing resistance to yellowing, classified in Class 162, subclass 134.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group I can be used for a different process than that of Group II, such as stabilizing photographic fixing solutions. The product does not require the "enhancing the resistance to yellowing" as required by the method of Group II.

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Because these inventions are distinct for the reasons given above and have required a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

During a telephone conversation with Mr. Hall on July 18, 2000 a provisional election was made without traverse to prosecute the invention of composition claims 1-40 and the species of, claims 5 and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-34 and 41-43 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant elected N,N-diethylhydroxylamine or its salt as the hydroxylamine and 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the stabilizer.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al in view of RODGERS et al.

SELTZER et al teaches adding mixtures of UV absorbers and light stabilizing agents, including N,N-diethylhydroxylamine (column 11, line 35 and column 12, line 66), to polymer coating compositions including polyurethane (column 8, line 12) and polyesters (column 8, line 30). RODGERS et al teaches using polyurethane and polyester coating compositions containing UV absorbers, including benzotriazoles (column 5, line 28 and Example 1), can be used to coat paper and textiles to prevent fading of dyes (column 1, lines 35-40 and abstract). It would have been obvious to the routineer that the polyesters and polyurathanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes, e.g. reducing the loss of brightness, in the manner taught by RODGERS et al. SELTZER et al teaches

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that benzotriazoles are of particular value as the UV absorber. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption.

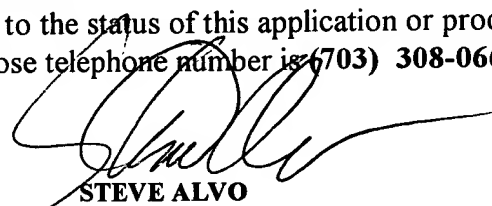
When filing an “Official” FAX in Art Unit 1731, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file. The “Official” FAX phone number for this Art Unit is (703) 305-7718 for all papers except amendments after final, for amendments after final the FAX number is 703-305-3599. When filing an “Unofficial” FAX in Group 1730, please indicate in the Header (upper right) “Unofficial” for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The “Unofficial” FAX phone number for this Art Unit (1731) is (703) 305-7115.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:30 AM - 3:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is (703) 308-0661.

MSA  
July 30, 2000



STEVE ALVO  
PRIMARY EXAMINER  
ART UNIT 1731